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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,068	02/02/2004	Chia-Yi Liang	LIAN3021/EM	5513
23364	7590	09/25/2007	EXAMINER	
BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314			STEELMAN, MARY J	
			ART UNIT	PAPER NUMBER
			2191	
			MAIL DATE	DELIVERY MODE
			09/25/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/768,068	Applicant(s) LIANG ET AL.	
	Examiner MARY STEELMAN	Art Unit 2191	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-6,10-16,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,2,4-6,10-16,19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>06/12/2007</u> .                         |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application  |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                          |

### **DETAILED ACTION**

1. This Office Action is in response to Claim Amendments and Remarks received 06/22/2007. Per Applicant's request, claims 1, 2, 4-6, 10-16, and 19-20 are amended. Claims 3, 7-9, 17-18 are cancelled. Claims 1, 2, 4-6, 10-16, 19, and 20 are pending.

### ***Claim Rejections - 35 USC § 101***

2. In view of amendments to claims 1 and 11, the prior 35 U.S.C. 101 rejection is hereby withdrawn.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-20 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10982932. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed towards setting states, generating instructions, and paths for workflow management.

Application 10 982932 claims methods and recording medium storing a computer readable and executable program versions with limitations such as:

A first terminal state, a second terminal state, and a third terminal state, generating a first instruction, a second instruction, and a third instruction, for the states respectively. Generating a first, second, third paths, pointing from the instruction to one of the states. Adding fourth and fifth states, instructions, and paths. Data is output from states via paths. Altering paths, etc.

Application 10 769068 claims system versions with limitations such as:

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Setting states, generating instructions and paths (first through fourth), outputting data from states via the paths, altering paths, wherein certain instructions associated with a state may be selected by associated personal at a specific terminal device.

The claim limitations are not patentable distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Examiner maintains the prior provisional obviousness type double patenting rejection.

***Claim Rejections - 35 USC § 112***

5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim language is incomplete. Independent claims 1 and 11 generate four paths: the first path points from the sending instruction to the debug department manager state, the second path points from the receiving instruction to the debug engineer state, the third path points from the returning instruction to the request form generating state and the fourth path points from the debug completing instruction. It is not disclosed where the fourth path points.

Claims 1 & 11 may be amended to recite that the fourth path points from the debug completing instruction to a generated fourth state, a work finishing state.

Claim 4 may be amended to recite:

The workflow defining system according to claim 1 wherein:

the instruction generating module generates a re-starting instruction for the work finishing state; and

the path generating module generates a fifth path according to the re-starting instruction, the fifth path pointing from the re-starting instruction to the debug department manager state.

6. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention. Evidence that claims fail to correspond in scope with that which applicant regard as the invention can be found in the reply filed 06/22/2007. In that paper, applicant has stated (Remarks, page 12, 2<sup>nd</sup> paragraph), “the positively recited feature of each different state having different instruction is shown in the **different terminal device provided for different user to select instruction to execute**”, and this statement indicates that the invention is different from what is defined in the claims because claims do not distinctly recite a collection of workflow states cooperating in a state machine, permitting certain identified users (personnel, engineer, manager) to select only certain instructions, at certain distinct terminal devices, said selectable instructions unique a given state and to each terminal device.

The novelty of the invention appears to be: a collection of workflow states cooperating in a state machine, permits certain identified users (personnel, engineer, manager) to select only certain instructions, at certain distinct terminal devices, said selectable instructions unique a given state and to each terminal device. As noted in Remarks, page 12, 2<sup>nd</sup> paragraph, “the positively recited feature of each different state having different instruction is shown in the **different terminal device provided for different user to select instruction to execute.**”

Claims 1 (and similarly for claim 11) may be amended to recite:

A workflow defining system, comprising:

a state setting module...

an instruction generating module...

a path generating...

...and the fourth path points from the debug completing instruction to a generated fourth state, a work finishing state;

wherein personnel of the debug request form generating department select instructions generated for the request form generating state, for execution, only on a first terminal device, a manager of a debug department selects instructions

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generated for the debug department manager state, for execution, only on a second terminal device, and a debug engineer selects instructions generated for the debug engineer state, for execution, only on a third terminal device.

The above amended phrase conveys that certain personnel are assigned to a specific terminal device with the ability to select instructions, limited to the associated terminal device and state.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Steelman, whose telephone number is (571) 272-3704. The examiner can normally be reached Monday through Thursday, from 7:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Zhen can be reached at (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Steelman

09/12/2007

MARY STEELMAN  
PRIMARY EXAMINER  
